

### III. REMARKS

#### Status of the Claims

Claim 20 is amended. Claims 3-11, 13, and 15-20 are presented for further consideration.

Applicant has amended the claims to clarify the novel features of the invention for which protection is sought in this application. These amendments are submitted after final rejection in order to place the claims in condition for allowance or in the alternative to place the claims in better condition for appeal. The Examiner is requested to exercise his discretion and enter these amendments.

#### Summary of the Office Action

Claims 3-6, 15, and 20 stand rejected under 35USC103(a) on the basis of the cited reference Prior (EP000913977A2) in view of the cited reference Takafumi(JP11284706). Claim 7 stands rejected under 35USC103(a) on the basis of the reference Prior in view of Takafumi and further in view of the reference Davidson, et al, U.S. Patent No. 5,841,855. Claims 8-11 stand rejected under 35USC103(a) on the basis of the reference Prior in view of the reference Takafumi and further in view of the reference Bannister (2012199). Claims 13, and 17 stand rejected under 35USC103(a) on the basis of the reference Prior in view of the reference Takafumi and further in view of the reference Gordon, U.S. Patent No. 5,884,156. Claim 16 stands rejected under 35USC103(a) on the basis of the reference Prior in view of the reference Takafumi and further in view of the cited reference Fishman, U.S. Patent No. 5,655,017. Claim 18 and 19 are rejected under 35USC103(a) on the basis of the reference Prior in view of the reference

Takafumi and further in view of "what is old and well known in the art".

#### Discussion of the Cited References

The Examiner continues to rely primarily on the reference Prior, et al to support the rejection of the claims in this application based on obviousness. The Examiner has further indicated that because there is duplication of certain functions keys, as shown in figure 6a, there is described a second user interface. Applicant submits that the key 67 having overlapping functions is merely supplemental to the single user interface. Considering that the device is for digital radio telephone a series of buttons that do not include a microphone and speaker cannot provide a second independent interface. There is no mention in the referenced paragraph 27 or anywhere else in the cited reference Prior, that a second interface, complete with microphone and speaker are provided.

The Examiner has failed to consider the clear implication of the language of claim 20. Applicant has made further amendments above to emphasize the aspect of the invention that allows the phone to be used when the first user interface is obstructed. The Examiner is respectfully requested to take these limitations into consideration. In the subject response, the Examiner has again characterized the reference Prior, as follows:

"Prior, et al further discloses in column 5, lines 34-35 and in figure six an alternative user interface on the rear of the handset, which reads on the claimed 'wherein said first and second functional elements cooperate to provide a first user interface for normal use of the radio telephone, and said third and second function elements cooperate to provide a second user interface for use when said first functional elements are obstructed'."

According to the excerpt cited by the Examiner, Prior shows in figure 6: "alternative user interface features". The reference also describes a user interface "input" 60. In this manner, a number of user interface components are described throughout the cited reference, that are accessible from the rear of the cell phone, but they are all used to manipulate the "actual" display that is on the front of the cell phone. According to Prior, this provides a number of advantages, for example as described at column 6, lines 13-24.

"Primarily, it enables the user to hold the handset and control the display information in one hand. It is advantageous to have a separate touch screen to the actual display as the display will not get dirty and its content obscured by dirt or the user's hand. Moreover, in single handed use, a user interface input on the front of the phone require thumb operation, whereas such an input on the rear can be operated by a forefinger, which is smaller and more agile than a thumb, and thus provides greater accuracy."

Clearly this indicates that Prior intended to have only one user interface with which to operate the cell phone and not two as in the subject invention. The aim of the solution of Prior is to arrange the input means of a single user interface, such that manipulating the content on the display is easier.

The components of the user interface of Prior, placed on faces other than the front, are just extended parts of a single user interface and do not operate independently. When the interface features on the front of the handset of Prior are obstructed, the handset is not operable. This is not the case with respect to the mobile telephone described in new claim 20 now under consideration. In the subject application, the third functional elements provide a means, with said second functional elements to operate the radio telephone when the first functional elements are obstructed. Such obstruction frequently occurs when the radio telephone is mounted in a carrier.

The aim of the present application is to enhance the usability of a radio-telephone. This problem is solved by creating two distinct user interfaces, which can be used in different operating conditions. The first user interface is employed, when the user holds the phone in hand. The second user interface is used in situations, where the first functional elements (including the display) of the phone are obstructed. This is the situation e.g. when the phone is placed on a carrying means and the front surface of the shell is facing the users shoulder, as shown in figure 3. According to the invention, the second user interface does not comprise a display.

In the description of Prior, et al. It is stated that there is provided:

**"a user interface comprising a display and input means responsive to a user to manipulate the contents of the display; wherein the display is provided on the front face and the input means on the rear face" (column 1, lines 25-29).**

Thus Prior et al. does not suggest that there are two user interfaces, but only one. Since the input means on the rear face in Prior are used to manipulate the contents on display on the front face, it is clear that the display and the input means both belong to the same user interface. Therefore there are no two separate user interfaces like in the present invention. This is further supported by the language of claim 1 of Prior.

Also, in Prior, an on/off button 4 is located on the upper part of the front surface of the shell (see figure 1). The upper part of the front surface is not the same thing as the upper surface of the shell, as stated in claim 20. In the subject application,

the upper surface refers to an upper end surface of the shell (see page 4, lines 27-29 of the description). Therefore, Prior does not disclose any keys on the upper end surface, only a headset connector (or its cover 41) as shown in figure 4.

The Examiner further asserts that figure 2 of Prior discloses keys on the side surface of the shell. This is not supported by the description, in which there is no mention of any such keys. Applicant submits, in light of similar telephone products on the market, that it is probable, the markings on the side surface of the shell are meant to illustrate notches for fixing the phone to a car holder.

The problem in Takafumi (JP 11284706) is to enhance the visibility of a display section and the operability of a key operation section of a portable telephone. To solve this problem a microphone and a speaker are placed on the opposite side of the display. There is only one user interface comprising a single display, microphone and speaker.

Both in Prior et al. and in Takafumi the problems to be solved are quite different than in the present application. Therefore a skilled person would not reach the present invention by combining these two solutions.

The reference Prior, et al fails to disclose a key feature of the subject invention, as defined in new claim 20. None of the additional references cited by the Examiner remedy this deficiency. The examiner's rejection of the claims under consideration, based on obviousness, is therefore, not supported by the cited references either alone or in combination.

### The Issue of Obviousness

It is well settled that in order to establish a prima facie case for obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, without reference to the disclosure of this application.

Applicant submits that the above described deficiencies of the primary reference Prior are not remedied by the proposed combination with the teaching of the reference Takafumi or any of the other cited references. The combined references do not therefore support a prima-facie case of obviousness. The modification of the teachings of Prior or Takafumi, Davidson, Bannister, or Gordon in order to obtain the invention, as described in the claims submitted herein, would not have been obvious to one skilled in the art.

It does not appear that the Examiner has considered the claims as a whole but has dismantled the claims and pursued a search for the individual features. It is well settled that "the actual determination of the issue requires an evaluation in the light of the findings in those inquiries of the obviousness of the claimed invention as whole, not merely the differences between the claimed invention and the prior art." (Graham v. John Deere Co., 383U.S.17). The court admonishes in In re Fritch, 972F.2d1260 as follow:

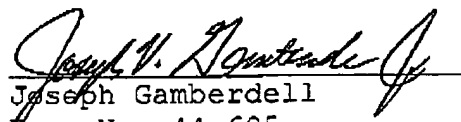
"It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."

The above arguments apply equally to the rejected dependent claims.

In view of the remarks stated above, Applicant submits that all of the claims under consideration contain patentable subject matter and favorable action by the Examiner is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,

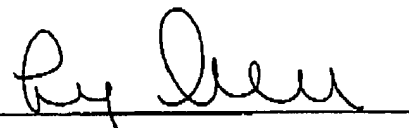
  
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